

**BEST AVAILABLE COPY****REMARKS**

Claims 1-12 and 19-21 are pending.

Claims 1-12 are rejected

Claims 13-18, the non-elected claims, are cancelled.

Claim 19-21 are new.

Claim 1 is amended to eliminate the action of "notifying said user of an availability of said television program". In addition, Claim 1 is amended for clarity purposes such as changing an "e-mail message" to an "electronic message".

Claim 4 is amended to correct the antecedent basis of the term "e-mail message" to "electronic message".

Claim 5 is amended to correct the antecedent basis of the term "e-mail message" to "electronic message".

Claim 10 is amended to change the term "e-mail message" to "electronic message".

Claim 11 is amended to eliminate the step of "entering said user-entered data via a data entry means" and the step of "notifying said user of an availability of said television program".

Claim 19 recites that the claimed electronic message is an "e-mail message", as claimed in original Claim 1.

Claim 20 recites that the claimed electronic message is an e-mail message, as claimed in original Claim 10.

Claim 21 recites that said user entered data is entered via a data entry means.

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No new matter was added to the application in view of the amendments.

Please note that the docket number of this case should be PU010001.

***I. 35 U.S.C. § 103 Rejection of Claims 1-12***

The Examiner rejects Claims 1-12 under 35 U.S.C. 103(a) as being anticipated by Alten al. (U.S. Patent # 6,396,546, hereafter referred to as 'Alten'). Applicant disagrees with this ground of rejection.

Claim 1 claims "memory means for storing data representing said channel guide list and at least one e-mail address". The Examiner then cites to line 6 of the abstract, the database of Fig. 42, and col. 12, line 2 of Alten to support the proposition that the claimed memory means is disclosed in Alten. Applicant notes that the references cited to in Alten are only representative of a "program schedule database" which is conditioned to store "received program schedule information to build a database by storing the data in appropriately organized records in dynamic random access memory," (Alten, col. 8, lines 7-10). Nothing in Alten discloses nor suggests that the described system of Alten that such a memory means would or could store "at least one e-mail address".

Moreover, the Examiner in the rejection states that the claimed "sending an e-mail message to the user at the at least one e-mail address to notify said user of an availability of said television program" upon a successful conclusion of a search in Claim 1 is obvious. Applicant notes that nothing in Alten discloses or suggests the desirability of transmitting the claimed e-mail results of Claim 1, in the manner stated by the Examiner. For example, the Examiner cites to Fig. 24 in Alten as being similar to the claimed electronic message of Claim 1 indicating the availability of a television. The pay per view confirmation of Fig. 24, however, is used for a different function, where the confirmation is used to confirm whether or not a user wants to order a specific movie, in this case "Passenger 57". This pay

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per view confirmation is not the same thing as "sending an electronic message to the user at the at an e-mail address to notify said user of an availability of said television program".

Furthermore, the claim requires that the claimed e-mail of Claim 1 be sent "upon successful conclusion of said search". The search claimed in Claim 1 is a different operation than the ordering of a movie as shown in Figs. 22 and 23 of Alten, as such an operation is to purchase a viewing of a movie. Additionally, Alten does not disclose or suggest why a user would want the results of purchasing a movie would or should be transmitted as e-mail to "an e-mail address" in the manner suggested by the Examiner. A user would probably want to confirm the purchase of a movie at the time the movie was being purchased.

Applicant asserts that the Examiner applies hindsight analysis in view of the claimed invention to modify the Alten reference to arrive at the claimed invention, for the reasons listed above. Applicant therefore requests that the Examiner remove the rejection to Claim 1. In addition for the reasons listed above, Applicant requests that the Examiner remove the rejection to Claims 2-9 as such claims depend on Claim 1. Additionally, Applicant requests that the Examiner remove the rejection to Claims 10-12, as such claims are patentable for the reasons listed above.

The Examiner, in the Final Office Action from March 11, 2005, responded to the above arguments by writing that the Office Action from April 9, 2004 already addressed these points. The Applicant asserts that the reasons given in the Final Office Action is not sufficient to establish the Examiner's responsibility listed in M.P.E.P. 707.07(f).

In addition, the Examiner wrote in the Final Office Action that, "using the e-mail for automatically or electronically passed back for information between users/computers through the computer network is a well known feature in the art at the time the invention was made".

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The Examiner cites to a section of Alten as supporting this conclusion. Specifically, the Examiner writes, "the data stream can be transmitted on the cable line in any number of ways and those skilled in the art will understand that numerous transmission schemes may be used to transmit the data stream," (Alten, col. 7, lines 53-58). The paragraph to which the Examiner cites then discloses further ways a data provider, such as a broadcaster, may transmit a data stream, such as embedding the data stream in the vertical blanking interval of a program broadcast signal (Alten, col. 7, lines 58-63). This disclosure of Alten is based upon how a broadcaster or data provider can provide an input signal 11 to a receiver 12. This teaching of Alten has nothing to do with disclosing or suggestion how one could send an electronic message to a third party (either from a broadcaster or the receiver 12 based upon the results of a search) without applying hindsight analysis in view of the Applicant's invention (M.P.E.P. 2145)

Additionally, the Examiner does not answer why Alten suggests the need for the combination proposed by the Examiner see *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). The REMINDER feature disclosed in col. 14, lines 36-55, does not disclose or suggest the need to send such reminders electronic message, as suggested by the Examiner, as e-mails. Specifically, the REMINDER message of Alten discloses a "TUNE" option which allows as user to tune to a selected program (Alten, col. 14, lines 56-58). Alten suggests that the REMINDER message should stay local to receiver 12 so that a user could immediately tune to a program, which would not be possible if the REMINDER message was sent as an e-mail (as suggested by the Examiner).

Applicant requests a one-month extension to submit this response under C.F.R. 1.136(a). The Applicant is also submitting this response as part of a Request for Continuing Examination. Please charge any fees owed in connection with this action to Deposit Account 07-0832.

It is believed that, in view of the preceding amendments and remarks,

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this application is in condition for allowance. Accordingly, reconsideration and allowance are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the Applicant's attorney at (609) 734-6809, so that a mutually convenient date and time for a telephonic interview may be scheduled.

Respectfully submitted,



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July 11, 2005